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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,433

11/26/2008

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EXAMINER

MORRISON, THOMAS A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,433	Applicant(s) PRINZ, MATTHIAS	
	Examiner THOMAS A. MORRISON	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 and its dependent claims 13-15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the structure or structural relationship between the recited elements in claim 12 that allows the duplex-printing mode to be set; (2) the structure or structural relationship between the recited elements in claim 12 that allows the paper jam to be detected; and (3) the structure or structural relationship between the recited elements in claim 12 that allows the completion of duplex-printing mode to be determined. The language in claim 12 does not specify which element or elements perform the claimed functions. Accordingly, it is unclear what arrangement is claimed in claim 12 and its dependent claims.

Claim 13 and its dependent claim 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary

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structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the structure or structural relationship between the recited elements in claim 13 that allows the simplex-printing mode to be set; (2) the structure or structural relationship between the recited elements in claim 13 that allows the completion of duplex-printing to be determined; (3) the structure or structural relationship between the recited elements in claim 13 that allows duplex-printing to be determined; (4) the structure or structural relationship between the recited elements in claim 13 that allows the completion of printing on a first side to be determined; and (5) the structure or structural relationship between the recited elements in claim 13 that allows the incomplete printing on a second side to be determined. The language in claim 13 does not specify which element or elements perform the claimed functions. Accordingly, it is unclear what arrangement is claimed in claim 13 and its dependent claim.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the structure or structural relationship between the recited elements in claim 14 that allows the duplex-printing to be determined; and (2) the structure or structural relationship between the recited elements in claim 14 that allows the completion of printing on one side of print media to be determined. The language in claim 14 does not specify which element

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or elements perform the claimed functions. Accordingly, it is unclear what arrangement is claimed in claim 14.

Claim 16 and its dependent claims 17-18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: (1) the omitted step of determining when duplex-printing is complete in claim 16; (2) the omitted step of determining when only one side of the print media has been printed in claim 16; (3) the omitted step of determining whether the printer is in a duplex-printing mode in claim 16; and (4) the omitted step of determining whether only one side of a print media has been printed in claim 16.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-14, 16-17 and 19-20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,550,762 (Stoll) (hereinafter “Stoll”).

Regarding claim 12, Figs. 1-3 show a printer (Fig. 1) for printing on a print media having at least duplex printing, the printer (Fig. 1) comprising:

(a) a transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B) for transporting the print media for printing;

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(b) a first switch (14B) for directing the print media through a first exit (exit to the right of element 14B) to a receiving receptacle (i.e., FINISHER) or for permitting the print media to continue on the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B); wherein when the printer is in duplex-printing mode and a paper jam is detected (via sensor 101B), the first switch (14B) transports the print media in which duplex-printing is complete out of the transport path via the first exit (i.e., exit located to the right of element 14B) and the print media in which only one side of the print media has been printed continues through the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B);

(c) a flap (14A) for transporting the print media through a second exit (near 15A) to a container (including 16A) not within the transport path or permitting the print media to continue on the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B); wherein when the printer is in duplex-printing mode and a paper jam is detected (via 101B), the flap (14A) passes the print media in which only one side of the print media has been printed out of the transport path via the second exit (15A) to the container (including 16A); and

(d) a flipping arrangement (including 15B, 16B, 18B and 19B) disposed within the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B) for flipping the print media for permitting printing on a second side of the printer.

Regarding claim 13, Figs. 1-3 show that the first switch (14B) exits the print media out of the first exit (exit to the right of element 14B) when in simplex-printing

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mode or when duplex-printing is complete or continues transporting the print media through the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B) when in duplex-printing and printing on a first side is complete and printing on a second side is incomplete.

Regarding claim 14, Figs. 1-3 show that second switch (14A) receives the print media in which, when in duplex-printing, one side of the print media has been printed and is continuing for printing on the second side.

Regarding claim 16, Figs. 1-3 disclose a method for printing on a printing material, the method comprising the steps of:

(a) detecting a paper jam (via element 101B) in a transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B);

(b) transporting the print media through a first exit (exit to the right of element 14B) to a receiving receptacle (i.e., FINISHER) not within the transport path or continuing to transport the print media on the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B); wherein when the printer is in duplex-printing mode and a paper jam is detected (via element 101B), transporting the print media in which duplex-printing is complete out of the transport path via the first exit (exit to the right of element 14B) to the receiving receptacle (i.e., FINISHER) and the print media in which only one side of the print media has been printed continues through the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B);

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(c) transporting the print media through a second exit (near 15A) to a container (including 16A) not within the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B) or continuing to transport the print media on the transport path (including 13, 15B, 17B, 19B and unnumbered dotted-line path connected to 19B); wherein when the printer is in duplex-printing mode and the paper jam is detected (via element 101B), transporting the print media in which only one side of the print media has been printed out of the transport path via the second exit (near 15A) to the container (including 16A); and

(d) providing a flipping arrangement (including 15B, 16B, 17B, 18B and 19B) disposed within the transport path for flipping the print media for permitting printing on a second side of the printer.

Regarding claim 17, Figs. 1-3 disclose the step of providing a flap (14A) for performing step (c).

Regarding claims 19 and 20, as best understood, the receiving receptacle (i.e., input of the FINISHER) can be considered to be a paper tray.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoll as applied to claims 12 and 17 above, and further in view of U.S. Patent No. 6,341,777 (Carter) (hereinafter "Carter"). Stoll discloses a flap (14A) that is actuated to divert sheets to one of multiple routes, but Stoll does not explicitly disclose that a solenoid is used to actuate such flap, as claimed in claims 15 and 18.

Carter discloses that it is well known in the art to provide a printer (column 1, line 9) with a flap (including 100) arrangement that is operated by a solenoid to divert sheets to one of multiple routes. See, e.g., col. 5, lines 29-31. Because both Carter and Stoll teach flaps (18A and 100, respectively) for diverting sheets to one of multiple routes, it would have been obvious to one skilled in the art to substitute a flap arrangement that is actuated by a solenoid for the flap arrangement of Stoll to achieve the predictable result of diverting sheets to one of multiple routes. Thus, all of the limitations of claims 15 and 18 are met by the cited combination of references.

Response to Arguments

4. Applicant's arguments filed 7/20/2010 have been fully considered but they are not persuasive.

The examiner disagrees with the first part of applicant's arguments involving 35 U.S.C. 112, first paragraph. No rejection for non-enablement was included in any office action for this case.

Rather, the language of the claims as written is too unclear to understand what structure is claimed. Further clarification is needed. What structure performs the claimed functions? Accordingly, the indefiniteness rejections have been repeated in this office action.

In response to applicant's arguments with regard to prior art, the examiner has included new rejections for claims 12-20 above, which point out first and second exits that direct paper out of the transport path, as now set forth in the claims.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stefano Karmis can be reached on (571) 272-6744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/24/2010

/Stefano Karmis/
Supervisory Patent Examiner, Art Unit 3653